

REMARKS

Claims 1-33 are pending in the instant application. The Examiner has rejected claims 10-21 under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. Further, claims 1-33 have been rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,128,626 to Beauchesne. Claims 10, 16, 20, 22, 28, and 32 have been canceled. Claims 1-9, 11-15, 17-19, 21, 23-27, 29-33 have been amended. New claims 34 and 35 have been added. The Applicants submit that the instant application is in condition for allowance for at least the reasons presented below. No new matter has been entered.

Rejections under 35 U.S.C. 101

Claims 10-21 have been rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory matter. The Applicants have canceled claim 10, 16 and 20 and have amended claims 11-15, 17-19, and 21. New claim 34 has been added to replace canceled claim 10. It is respectfully submitted that claims 11-15, 17-19, 21 and 34 recite matter that is within the technological arts and that the matter recited produces a useful, concrete, and tangible result. Reconsideration of the outstanding rejections is respectfully requested.

YOR920000812US1/D28-0001

Rejections under 35 U.S.C. 102(e)

Claims 1-33 have been rejected under 35 U.S.C. 102(e) as allegedly anticipated by Beauchesne. The Applicants have amended claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33. Further, claims 10, 16, 20, 22, 28, and 32 have been canceled. New claim 34 has been added to replace claim 10. New claim 35 has been added to replace claim 22. The Applicants submit that the amendments have been made to better clarify that which is regarded as the invention and are not to be construed as conceding to the rejections outlined in the Office Action. The outstanding rejections are traversed for at least the reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

YOR920000812US1/L28-0001

Applicants' amended claim 1 recites "a server in communication with a workstation over a network, the workstation executing a design tool application; a bill of material assist application executing on at least one of the server and the workstation for managing said parts requirements processes, the bill of material assist application performing: receiving a bill of material including a list of component parts in response to a product design conducted on the workstation; mapping each component part in the list to corresponding part selection process information, the corresponding part selection process information acquired from the plurality of external sources; and generating a summary resulting from the mapping; wherein for each of the component parts in the list, the corresponding part selection process information includes at least one of: a lead time; a current supply status; at least one supply source; a cost; an end-of-life data; and a preferredness rating."

Beauchesne does not recite these features. Beauchesne is directed to "eliminating the amount of duplicate information contained in a manufacturing database" and for providing "historical information with minimum increase in database storage requirements" (col. 3, lines 17-24). Beauchesne is not even remotely related to the applicants' invention. The processes recited in Beauchesne provide a database management process that reduces the amount of storage space utilized for design information. Part information is broken down and organized into tables. When changes are made to an existing design, the change is captured in the system and the tables are updated to reflect the changes in design. Beauchesne further teaches a process for

Y0R920000812US1/L28-0001

disassembling a bill of material (e.g., breaking down part information for tables) but not does not teach creating a bill of material and does not include processes for performing any type of parts management. Accordingly, the Applicants submit that claim 1 is not anticipated by Beauchesne because Beauchesne does not recite each and every element of claim 1. Reconsideration of the rejection is respectfully requested. Claims 2-9 depend from what is an allowable claim 1. For at least this reason, the Applicants submit that claims 2-9 are in condition for allowance. New claim 34 recites a method for providing managing parts requirements processes and new claim 35 recites a storage medium for providing managing parts requirements processes. New claims 34 and 35 are allowable at least for the reason provided above with respect to claim 1. Claims 11-15, 17-19, and 21 depend from what is an allowable claim 34. Claims 23-27, 29-31, and 33 depend from what is an allowable claim 35. For at least this reason, the Applicants submit that claims 11-15, 17-19, 21, 23-27, 29-31, and 33 are in condition for allowance. Reconsideration of the outstanding rejections is respectfully requested.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that

YOR920000812US1/I28-0001

such fee be charged to Deposit Account No. 50-0510 maintained by Applicants' Assignee.

Respectfully submitted,

CANTOR COLBURN LLP

By Marisa J. Dubuc

Marisa J. Dubuc
Registration No. 46,673
Customer No. 48915

Date: December 2, 2004
Address: 55 Griffin Road South, Bloomfield, CT 06002
Telephone: (860) 286-2929

YOR920000812US1/I28-0001